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Steven B. Kelber Berenato & White, LLC 6550 Rock Spring Drive Suite 240 Bethesda, MD 20817			EXAMINER AMARI, ALESSANDRO V	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIM HUNTER, CHRIS GUDEMAN,
DAVID T. AMM, and AKIRA TOMITA

Appeal 2009-005369
Application 10/050,994
Technology Center 2800

Before ROBERT E. NAPPI, CARLA M. KRIVAK, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

KRIVAK, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1 and 3-10. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants' claimed invention is a grating light valve having a plurality of spaced reflective ribbons spatially arranged over a semiconductor substrate. The ribbons and substrate have reflective surfaces. The grating light valve configuration optimizes constructive and destructive interference from an incident light source having a given wavelength. (Abstract) That is, the grating light valve modulates reflected light (Spec. 1:9-14).

Independent claim 1, reproduced below, is representative of the subject matter on appeal.

1. A reflective light processing element, comprising:

a substrate;

a dielectric layer formed on the substrate;

a conductive trace formed on the dielectric layer, the conductive trace allowing charges trapped at the dielectric layer to escape wherein said trapped charges are present at least on the surface of the dielectric layer; and

a plurality of ribbons formed above the substrate and the conductive trace.

REFERENCES

Bloom	US 5,311,360	May 10, 1994
Hawkins	US 6,233,087 B1	May 15, 2001

The Examiner rejected claims 1, 3-8 and 10 under 35 U.S.C.
§ 102(e) based upon the teachings of Hawkins.

The Examiner rejected claim 9 under 35 U.S.C. § 103(a) based upon the teachings of Bloom.

Appellants contend their invention was conceived and reduced to practice prior to Hawkins. Appellants also contend the Examiner is incorrect in requiring evidence that Appellants' device was actually tested. (App. Br. 9-10; Reply Br.2-3).

ISSUE

Did the Examiner err in requiring evidence that Appellants' device was actually tested, thus allowing Hawkins to be used in rejecting the claims under 35 U.S.C. §§ 102 and 103?

ANALYSIS

Appellants argue the Examiner's rejection of claims 1, 3-8 and 10 as anticipated by Hawkins is in error as Hawkins is not a reference. Appellants submitted various Declarations for supporting the allegation their invention antedates Hawkins (App. Br. 9-10).²

The Examiner finds none of the Declarations submitted by Appellants state "that testing of the device was undertaken or show any results of such testing to demonstrate that the claimed invention worked for its intended purpose to establish actual reduction to practice" (Ans. 7, 8). That is, the Examiner does not assert conception or diligence as an

² Declaration of Hunter, Gudeman, Amm, and Tomita filed January 22, 2004; Declaration of Joe Berger filed December 28, 2004; Declaration of Hunter filed August 17, 2005; Declaration of Hunter and Amm filed April 10, 2007; and Declaration of Webb filed April 10, 2007. .

issue, only actual reduction to practice based on lack of testing data (Ans. 9-10). The Examiner cites MPEP § 715.07 to support this argument by finding this section states the “terms ‘conception,’ ‘reasonable diligence,’ and ‘reduction to practice’ have the same meaning under 37 CFR 1.131 as they have in interference proceedings” (Ans. 14-15). The Examiner’s arguments are misplaced.

Although the portions of MPEP § 715.07 cited by the Examiner are correct, the Examiner has not taken into consideration the entirety of this section; rather this section was taken out of context. MPEP §§ 715.07 II and III set forth the establishment of dates and ways to show prior invention.

The Examiner asserted there are no dates on the Exhibits provided, thus, it is not clear the testing occurred prior to December 1998, as noted by Appellants (Ans. 10). With respect to establishing dates, § 715.07 II states if the dates of the exhibits have been removed or blocked off, this can be taken care of in the declarations. Appellants have done so with their Declarations of Hunter and Amm, Webb, and Hunter, Gudeman, Amm, and Tomita. These declarations all state that, although there are no dates on the Exhibits/attachments, the type of testing reflected by the Exhibits/attachments was performed before December 18, 1998 (App. Br. 9, 10, 11, 12, 13, 15). The Declaration of Hunter, Gudeman, Amm, and Tomita specifically states the date of Exhibit A (Summary) was redacted, but the inventors confirm it was prior to December 18, 1998 (Para. 5; App. Br. 10).

MPEP § 715.07 III also states proof of *actual* reduction to practice requires a showing the apparatus actually existed and worked for its intended purpose. It appears from the Declarations and the Exhibits attached thereto, the device existed and worked.

Additionally, under 37 CFR 1.131, unlike interference practice, reduction to practice requires proof of utility only if the reference discloses a utility (MPEP 715.07 III). Further, “averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant may stand on her or her own affidavit” (citing *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953)). Thus, contrary to the Examiner’s assertions, we do not find that test results are required to establish utility in light of the information Appellants provided in the declarations and exhibits stating the apparatus existed and worked for its intended purpose as a grating light valve before the effective date of Hawkins (App. Br. 11-12, 13). The Examiner acknowledges Exhibit A of the Declaration of Hunter and Amm does show “some sort of charging test was conducted,” however, there is “ambiguity and uncertainty as to exactly when testing took place” as averred to by Appellants (Ans. 9). As noted above, Appellants may stand on their declaration without requiring corroboration. The claimed invention is a reflective light processing element/grating light valve. The evidence provided in Appellants’ Declarations supports the device was made. Indeed, it is this type of documentary evidence (notebook entries, sketches, descriptions of processes for making the invention) showing an actual, physical construction of the invention that is needed to prove an actual reduction to practice. See *Wetmore v. Quick*, 536 F.2d 937, 941 (CCPA 1976)

(“[A]n actual reduction to practice requires a showing of an embodiment of the invention in a *physical or tangible form* which shows every element of the invention defined in the count, and which demonstrates the utility of the invention.”) (emphasis added); *see also* MPEP §§ 2138.05(II)-(III). This, Appellants have done in the form of numerous Declarations and Exhibits, specifically, Exhibit B in the Declaration of Hunter. Further, Appellants’ invention was constructively reduced to practice when the application was filed. (*Frazer v. Schlegel*, 498 F.3d 1283, 1288 (Fed. Cir. 2007) “The filing of a patent application is a constructive reduction to practice of the invention disclosed therein.” Accordingly, Appellants have provided sufficient evidence to antedate Hawkins.

The Examiner relied on the combination of Bloom and Hawkins, in rejecting claim 9. However, as Hawkins is no longer a reference, the combination of Hawkins and Bloom does not render claim 9 obvious.

CONCLUSION

The Examiner erred in requiring evidence Appellants’ device was actually tested, thus Hawkins cannot be used in rejecting the claims under 35 U.S.C. §§ 102 and 103.

DECISION

The Examiner's decision rejecting claims 1 and 3-10 is reversed.

REVERSED

KIS

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